

Remarks

I. Introduction

This paper is filed in response to the final Office Action mailed July 17, 2008. Claims 3, 15, and 18 are amended. After entry of the present amendment, claims 3 - 16 and 18 - 20 remain pending in the present application.

Applicant traverses each of the Examiner's rejections. Reconsideration and allowance of all pending claims is respectfully requested in view of the remarks below.

II. Objection to the Specification

The Office Action objected to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action contended the claim term "computer-readable medium" is not sufficiently supported by the specification. Per the suggestion in the Office Action, the claims are amended to recite a "computer-storage medium." Withdrawal of the objection is kindly requested.

III. Rejections under 35 U.S.C. § 102(b)

The Office Action rejected claims 3, 15 – 16, and 18 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,815,830 to Anthony. For the

reasons set forth below, Applicant respectfully traverses this rejection and requests its reconsideration and withdrawal.

To sustain a rejection under 35 U.S.C. § 102(b), each element as set forth in a claim must be expressly or inherently described in a single prior art reference. MPEP § 2131. Anthony fails to describe each element as set forth in claims 3, 15 - 16, and 18. Thus, Anthony fails to anticipate claims 3, 15 - 16, and 18 under Section 102.

Anthony discloses conducting a comparison with the topic names for a page prior to displaying the first page of topic text. *See, e.g.*, Anthony, Col. 4, lines 61 - 63; Fig. 4. The comparison is conducted by automatically searching topic names in the body of text of the first page. *Id.* at Col. 4, lines 63 – 65. A comparison for subsequent pages of that topic is also undertaken again by automatically searching for the occurrence of the topic names in each of the subsequent pages. *Id.* at Col. 5, lines 21 - 24. The comparison is undertaken preemptively while the first page of text is displayed until the entire text for the topic has been compared. *Id.* The subsequent pages of text are thus linked while the user reads the first page. *Id.* at Col. 5, lines 24 - 29.

The linking of the pages of text in Anthony is performed automatically on portions of data thereby to link the data portions. The data content determines the sequence of the linked data portions. As such, there can be no links between the data portions without the data content.

In contrast, the present invention provides a database framework within which data can be stored. The terms “portions” and “sub-portions” used in the specification and claims accompanying the present application, relate to portions of the database and not to portions of data as is the case with reference to “data portions” in the disclosure in Anthony. As such, the “portions” and “sub-portions” referred to in the present application are “data-receiving” portions and sub-portions of a database in which data can be manually inserted by an author. Navigation in accordance with the present invention is thus provided by the framework of the database – independent of content – that is different than being provided based on the data content as disclosed by Anthony. The linking of the sub-portions of each portions of the database enables the linking of data content in similar fashion when the sub-portions are manually populated with data by an author.

Since Anthony fails to disclose or suggest “the database comprising a plurality of portions, each of the plurality of portions being subdivided into sub-portions in which information is stored” and “program instructions for linking the sub-portions of each of the plurality of portions of the database to one another in a predetermined sequential arrangement such that, when the information is stored in the sub-portions, each subsequent sub-portion in the predetermined sequential arrangement contains further information on the topic,” as recited in claim 3, Anthony fails to anticipate claim 3. Claims 15 and 18 recite similar elements. Thus, Anthony fails to anticipate

these claims, along with dependent claim 16, as well. Applicant kindly requests withdrawal of the rejection.

IV. Rejection of Claims 4 - 7, 14, and 19 - 20 under 35 U.S.C. § 103(a)

The Office Action rejected claims 4 - 7, 14, and 19 - 20 under 35 U.S.C. § 103(a) as being allegedly obvious over Anthony in view of U.S. Publication No. 2001/0047358 to Flinn, *et al.* Claims 4 - 7, 14, and 19 - 20 depend from and further limit one of claims 3 and 18, for which reasons for allowance are provided above. Applicant submits that claims 4 - 7, 14, and 19 - 20 are patentable for at least those same reasons. Withdrawal of the reject is kindly requested.

Moreover, in combining Anthony and Flinn to reject claims 4 - 7, 14, and 19 - 20 under Section 103(a), the Office Action failed to articulate the required findings to establish *prima facie* obviousness. The Office Action's alleged reason why one of ordinary skill in the art would combine Anthony and Flinn appears to be "some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." *See, e.g.*, Office Action, p. 9. The Office Action's mere conclusory statements that there is some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings are impermissible. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)(“[R]ejections on obviousness grounds cannot be sustained

by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)

MPEP Section 2143(G) identifies the findings Office personnel must articulate to reject claims on the basis of some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings. The findings include the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was a reasonable expectation of success;
and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration.

The Office Action failed to articulate findings for at least (1) and (2) above or merely offered conclusory statements for these and other required findings. Accordingly, the Applicant submits that the Office Action failed to establish *prima facie* obviousness and requests withdrawal of the rejection. Should the Office still opine, after reviewing the present response, that one or more of the pending claims are obvious, a full and clear statement of the grounds on which these claims are rejected

pursuant to MPEP Section 707.07(d) is requested so that any rejection is clearly articulated to provide the Applicant with the opportunity to provide evidence of patentability or otherwise reply completely at the earliest opportunity. *See* 35 U.S.C. § 132; MPEP § 706.

V. Rejection of Claims 8 - 11 under 35 U.S.C. § 103(a)

The Office Action rejected claims 8 - 11 under 35 U.S.C. § 103(a) as being allegedly obvious over Anthony in view of Flinn and U.S. Patent No. 6,714,215 to Flora, *et al.* Claims 8 - 11 depend from and further limit claim 3, for which reasons for allowance are provided above. Applicant submits that claims 8 - 11 are patentable for at least those same reasons. Withdrawal of the reject is kindly requested.

Moreover, in combining Anthony, Flinn, and Flora to reject claims 8 - 11 under Section 103(a), the Office Action failed to articulate the required findings to establish *prima facie* obviousness. The Office Action's alleged reason why one of ordinary skill in the art would combine Anthony, Flinn, and Flora appears to be "some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." *See, e.g.*, Office Action, p. 11. The Office Action's mere conclusory statements that there is some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings are impermissible. *See In re Kahn*, 441 F.3d

977, 988 (Fed. Cir. 2006)(“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)

Applicant submits that the Office is unable to make the required findings identified in Section IV above and submits claims 8 - 11 are patentable over the cited references. Allowance of claims 8 - 11 is kindly requested.

VI. Rejection of Claims 12 - 13 Under 35 U.S.C. § 103(a)

The Office Action rejected claims 12 - 13 under 35 U.S.C. § 103(a) as being allegedly obvious over the following four references:

1. Anthony;
2. Flinn;
3. Flora; and
4. U.S. Patent No. 5,761,436 to Nielsen.

Each of claims 12 - 13 depend from and further limit claim 3, for which reasons for allowance are provided above. For at least the same reasons, Applicant submits claims 12 - 13 are patentable in view of the cited references and requests allowance of claims 12 - 13.

Moreover, in combining Anthony, Flinn, Flora, and Nielsen to reject claims 12 - 13 under Section 103(a), the Office Action failed to articulate the required findings to establish *prima facie* obviousness. The Office Action’s alleged reason why one of

ordinary skill in the art would combine Anthony, Flinn, Flora, and Nielsen appears to be “some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.” *See, e.g.*, Office Action, p. 12. The Office Action’s mere conclusory statements that there is some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings are impermissible. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)(“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)

Applicant submits that the Office is unable to make the required findings identified in Section IV above and submits claims 12 - 13 are patentable over the cited references. Allowance of claims 12 - 13 is kindly requested.

Conclusion

The undersigned respectfully submits that all pending claims are in a condition for allowance. Any fees due at this time may be charged to Deposit Account number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404 745-2520.

Respectfully submitted,

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Date: October 17, 2008

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